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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,107	02/13/2001	Mihal Lazaridis	555255012189	3129

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EXAMINER

EDELMAN, BRADLEY E

ART UNIT	PAPER NUMBER
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2153

22

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,107

Applicant(s)

LAZARIDIS ET AL.

Examiner

Bradley Edelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29,42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29,42 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 18.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

This action is in response to Applicant's declaration and request for reconsideration filed on August 21, 2003. Claims 1-29, 42, and 43 are presented for examination.

Election/Restrictions

Applicant has canceled all non-elected claims, so the previous restriction requirement no longer applies.

Response to Amendment

The Affidavit filed on August 21, 2003 under 37 CFR 1.131 is sufficient to overcome the Wright, Adler, and Moon references.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-10, 13, 16, 22, 24-26, 28, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile (AirMobile Wireless Software for Lotus cc:Mail, Motorola, 1995), in view of Takahashi et al. ("Communication Method with Data

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Compression and Encryption for Mobile Computing Environment," ISOC INET Proceedings, June, 1996, hereinafter "Takahashi").

In considering claim 1, AirMobile discloses an electronic message redirection system, comprising:

A host system (AirMobile Wireless for cc:Mail Server) having a redirector application, wherein the redirector application is configured to sense a trigger event ("Enable" message) and in response to the trigger event to continuously redirect electronic message from the host system to a mobile data communication device (p. 17, "Enable/Disable" paragraph); and

A wired network coupled to the host system, a wireless data network coupled to the mobile device, and a wireless gateway ("wireless network adapter") coupled between the wired network and the wireless data network for transmitting messages between the wired and wireless networks (p. 9, Fig. 1-1);

Wherein a packaging module at the host system packages the electronic messages into electronic envelopes prior to redirecting messages over the wireless link through the wireless gateway, and the mobile device includes a corresponding unpackaging module for extracting the electronic messages from the electronic envelopes (this packaging and unpackaging of messages send from an e-mail server to an e-mail client is inherently included in the system; see pp. 30-31, describing the mail forwarding system).

However, AirMobile does not disclose including encryption modules and compression modules at the host system and corresponding decryption and

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decompression modules at the mobile device for encrypting and compressing messages, such that messages remain packaged, encrypted and compressed, and thus secure, throughout the message redirection process. Nonetheless, packaging, encrypting and compressing messages sent from a wired to a wireless network in such a manner is well known, as evidenced by Takahashi. In a similar art, Takahashi discloses a communication system for use in mobile computing environments, wherein a host server or client packages, encrypts, and compresses messages to be sent to mobile devices, and wherein the messages are decrypted, unpackaged, and decompressed at the wireless device, thereby utilizing a secure, end-to-end messaging process (see Fig. 1, showing the wired-to-wireless system, with hosts, PCs, and a wireless gateway, and a wireless device; Fig. 7, showing the end-to-end encryption, compression, and packaging method; see also p. 2, ¶ 1, 3; p. 5, ¶ 2; p. 6, ¶ 3, 4).

Given the teaching of Takahashi, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using the packaging, encryption, and compression method taught by Takahashi at the host system in the wired-to-wireless messaging system taught by AirMobile for obvious reasons (i.e. to increase security and save bandwidth on the system, or, as stated by Takahashi, to "easily achieve secure and efficient communication with all existing communication application programs and popular TCP/IP programs," p. 6, Conclusion). Thus, it would have been obvious to use the packaging, encryption, and compression method taught by Takahashi by the host system in redirecting the messages in the system taught by AirMobile.

In considering claims 2-7, claims 2-7 contain no further limitations over claim 1, and merely separate the features disclosed in claim 1 into separate dependent claims. Thus, claims 2-7 are rejected for the same reasons as stated with respect to claim 1.

In considering claim 8, claim 8 contains the further limitations of detecting that a redirection trigger has occurred and generating a redirection trigger, receiving messages directed to a first address at the host system from plurality of message senders, and in response to the trigger, continuously redirecting messages between the host system and the mobile device via the secure link. Except for the secure link aspect, these additional features are further taught by AirMobile. See p. 30, ¶ 5-6; p. 31, ¶ 1-2, describing the continuous redirection system; see also, p. 17, ¶ 4, describing the enable/disable trigger for initiating continuous redirection.

In considering claim 9, AirMobile further discloses receiving messages at the mobile device, transmitting reply messages from the mobile device to the host system and configuring the messages at the host system before sending the messages to message senders (p. 38, point 4), wherein the reply messages use the first address associated with the host system as the originating address (i.e. "Mitch Hansen@99999999"), such that messages generated at either the host system or the mobile device share the first address (i.e. the same cc:Mail program is used to send messages from the wireless device or from the host).

In considering claim 10, AirMobile further teaches storing information regarding the configuration of the mobile data communication device at the host system (p. 29).

In considering claim 13, AirMobile further discloses determining whether the receiver address is associated with the mobile device, if so then determining a network address of the mobile device and repackaging the messages into electronic envelopes addressed using the receiver address and the network address of the mobile device, and after receiving the messages at the mobile device, extracting the messages from the envelopes and displaying the messages using the sender and recipient addresses so it appears that the mobile device is the host system (p. 17, 39).

In considering claim 16, AirMobile further discloses that the redirection events include external, internal, or networked events (p. 17, ¶ 4, enable/disable trigger).

In considering claim 22, AirMobile further discloses that the mobile device is a wirelessly enabled laptop (Fig. 1-1).

In considering claims 24-26, and 28, AirMobile further discloses the preferred list activated and deactivated at the host, wherein senders can be added and subtracted to the list by configuring the host system (p. 42, describing setting filters at the host according to sender).

In considering claim 42, claim 42 presents no further limitations over claims 9 and 13, and is thus rejected for the same reasons as stated regarding claims 9 and 13.

2. Claims 11, 12, 17, 27, 29, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile and Takahashi, in view of MobileVision (Mobile Vision User Manual, CE Software, 1995).

In considering claim 11, AirMobile further discloses that the configuration information stored at the host system includes the network address of the mobile device (p. 29), and further discloses rules regarding which attachments should be received and processed at the mobile device (p. 45). However AirMobile does not disclose determining the types of messages that the mobile device can receive (i.e. is capable of receiving). Nonetheless, determining which attachments a mobile device is capable of receiving is well known in the art, as evidenced by MobileVision.

In a similar art, MobileVision discloses an e-mail forwarding system for forwarding messages from a host to a mobile device, including separating an attachment from a message, and redirecting the message from the host system to the mobile device and further discloses that attachments that the mobile device cannot receive (according to the enclosure rules may be removed from the e-mail prior to the e-mail being forwarded to the mobile device (p. 4-25; 4-32)). Thus, it would have been obvious to a person having ordinary skill in the art to use such an attachment processing scheme in the system taught by AirMobile so that extremely large

attachments, or attachments of a particular type that can't be processed by the mobile device taught by AirMobile, do not waste network bandwidth by being sent to a device that cannot process them.

In considering claim 12, AirMobile further discloses that the host stores an indication of the type of mobile device (p. 21, wherein the ID format indicates the type of receiving modem).

In considering claim 17, MobileVision further discloses that the trigger for sending messages to the mobile device can comprise a message sent from the wireless device (see pp. 4-21 – 4-23). It would have been obvious to include this in the system taught by AirMobile so that users can trigger forwarding from anywhere, instead of from only a limited number of places.

In considering claims 27 and 29, MobileVision further discloses that the user can add or subtract senders on a filter list by sending a message from the wireless device (see p. 4-26).

In considering claim 43, AirMobile further teaches that the system could run via a paging protocol (i.e. CDPD, p. 8). In addition, MobileVision further discloses that the device could be an e-mail enabled paging PDA (p. 1-1). Thus, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using

the e-mail forwarding system taught by AirMobile and Takahashi and MobileVision on pagers, instead of laptops or even pdas, because pagers are smaller than either of those and are thus easier to carry. Therefore, it would have been obvious to use the messaging system taught by AirMobile, Takahashi, and MobileVision for a pager.

3. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile and Takahashi, in view of MobileVision, and further in view of Theimer et al. (U.S. Patent No. 5,493,692, hereinafter "Theimer")

In considering claim 14, again, AirMobile additionally discloses determining whether messages include attachments, and removing attachments and processing the messages according to user-selected criteria (p. 45). Again, as discussed with regard to claim 11, MobileVision discloses determining the types of messages that the mobile device should receive (p. 4-25; 4-32) and sending them to the mobile device. However, neither AirMobile nor MobileVision disclose redirecting the attachments to a device capable of processing the attachments, if it is determined that the mobile device cannot process them. Nonetheless, this step is well known, as evidenced by Theimer.

In a similar art, Theimer discloses a system for selectively delivering electronic messages to one or more users who are using a mobile communication device (col. 24, lines 49-55), wherein the messages will be redirected from a host (server) to an appropriate display device according to device characteristics, the context, and the message characteristics (col. 25, lines 17-38). Thus, given the teaching of Theimer, a person having ordinary skill in the art would have readily recognized the desirability and

advantages of forwarding the attachments removed by the host in the system taught by AirMobile and MobileVision to an appropriate display device, as taught by Theimer, so that a user at a remote location can view the attachment immediately (see Theimer, col. 25, lines 23-38). Therefore, it would have been obvious to forward the attachments taught by AirMobile and MobileVision to a user via the display device system taught by Theimer.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile, Takahashi, MobileVision, and Theimer, further in view of Cooper et al. (U.S. Patent No. 6,052,442, hereinafter "Cooper").

In considering claim 15, Cooper further discloses that attachments to messages may be sound files, and that such attachments can be processed by an appropriate device (i.e. audio attachments may be played on a answering machine speaker, see col. 3, lines 25-28). It would have been obvious to a person having ordinary skill in the art to include audio attachments to the messages in the combined system taught by AirMobile, MobileVision, and Theimer, so that users can obtain important voice messages when on the road.

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile and Takahashi, in view of Dunker (CE Software Announces MobileVision, CE Software, Inc., 1995, hereinafter "Dunker").

In considering claim 21, although the system taught by AirMobile and Takahashi discloses substantial features of the claimed invention, it fails to disclose the networked events including messages to begin redirection from computer systems other than the mobile data communication device, which are connected to the host system via a wired network. In a similar art, Dunker discloses a system for forwarding messages from a host system to a mobile device, wherein a plurality of desktop systems are in communication with the host, and the operation of the forwarding program can be configured using one of the plurality of desktop systems (p. 1, paragraph 5, "rules can be modified at either the office or from the road"). Therefore, given the teaching of Dunker, a person having ordinary skill in the art would have readily recognized the desirability and advantages of allowing users at networked stations to control redirection of the system in case a user loses his/her mobile device and still wants to receive the messages. Therefore, it would have been obvious to control the forwarding of messages in the system taught by AirMobile and Takahashi via a networked computer, as taught by Dunker.

6. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile, in view of Takahashi, and further in view of Owens et al. (U.S. Patent No. 6,023,700, hereinafter "Owens").

In considering claim 23, although the system taught by AirMobile and Takahashi discloses substantial features of the claimed invention, it fails to disclose that the mobile device can process voice and non-voice data messages. Nonetheless, receiving voice

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attachments to e-mail is well known, as evidenced by Owens. In a similar art, Owens teaches a system for forwarding electronic mail messages from a host to a recipient, wherein the messages can include voice attachments (col. 3, lines 49-64; Abstract). Thus, given the teaching of Owens, a person having ordinary skill in the art would have readily recognized the desirability and advantages of including voice attachments as one of the attachments taught by AirMobile in the combined system of AirMobile and Takahashi, so that blind users can easily receive messages. Therefore, it would have been obvious to allow the laptop taught by AirMobile to receive both voice and non-voice attachments.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuki (EP Patent No. 772,327 A2), in view of Takahashi.

In considering claim 19, Kuki discloses a method of exchanging messages between a host system and a wireless mobile data communication device via a wireless communication network (col. 4, lines 10-20), including configuring one or more redirection events at the host system (col. 4, lines 50-54), detecting that a redirection event has occurred at the host and generating a redirection trigger, and in response to the trigger, exchanging messages between the host system and the mobile device by continuously redirecting the messages received at the host system to the mobile device (col. 5, lines 37-43; col. 6, lines 22-30). Kuki further discloses that the redirection event is a calendar alarm. Although Kuki does not explicitly disclose a wireless gateway for

connecting the wired and wireless network, such a gateway is inherent and would be necessary to complete the wired-to-wireless communication.

In addition, although Kuki does not disclose the use of a secure link between the host system and the wireless device, such a link is well known, as taught by Takahashi, and would have been obvious to include in the system taught by Kuki to improve the network bandwidth usage and security of the system (as discussed previously in this action).

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuki, in view of Takahashi, and further in view of Kumomura (U.S. Patent No. 5,850,219).

In considering claim 19, Kuki discloses a method of exchanging messages between a host system and a wireless mobile data communication device via a wireless communication network (col. 4, lines 10-20), including configuring one or more redirection events at the host system (col. 4, lines 50-54), detecting that a redirection event has occurred at the host and generating a redirection trigger, and in response to the trigger, exchanging messages between the host system and the mobile device by continuously redirecting the messages received at the host system to the mobile device (col. 5, lines 37-43; col. 6, lines 22-30). Kuki further discloses that the redirection event is an internal event (i.e. calendar alarm). Although Kuki does not explicitly disclose a wireless gateway for connecting the wired and wireless network, such a gateway is inherent and would be necessary to complete the wired-to-wireless communication.

In addition, although Kuki does not disclose the use of a secure link between the host system and the wireless device, such a link is well known, as taught by Takahashi, and would have been obvious to include in the system taught by Kuki to improve the network bandwidth usage and security of the system (as discussed previously in this action).

Finally, although the system taught by Kuki teaches an internal event for triggering redirection of messages, it does not disclose that the event is a screen saver activation. Nonetheless, the use of a screen saver activation to trigger redirection of electronic messages is well known in the art, as evidenced by Kumomura. In a similar art, Kumomura discloses a system for receiving electronic mail at a client machine, wherein received messages are redirected to another networked device if a screen saver is activated (col. 4, lines 58-61, 64-65). Thus, given the teaching of Kumomura, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using a screen saver activation as a redirection event in the system taught by Kuki and Takahashi, so that a user who is most likely away from her host computer can still receive incoming messages at her mobile device (see Kumomura, col. 4, lines 61-64). Therefore, it would have been obvious to include the screen saver activation feature taught by Kumomura in the message redirection system taught by Kuki and Takahashi.

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuki, in view of Takahashi and Kumomura, and further in view of Rakavy et al. (U.S. Patent No. 5,913,040, hereinafter "Rakavy").

In considering claim 20 although the combined teaching of Kuki, Takahashi, and Kumomura does not explicitly discuss a keyboard timeout signal, the use keyboard timeout signals to trigger screen saver activation is well known, as evidenced by Rakavy. In a similar art, Rakavy discloses a system for triggering a network communication between a home computer and a remote computer, wherein a keyboard timeout will activate a screen saver and thus trigger the network communication (col. 7, line 63 - col. 8, line 3). Given the teaching of Rakavy, it would have been obvious to a person having ordinary skill in the art to use a keyboard timeout to activate a screen saver, thereby activating redirection of the messages disclosed in the system taught by Kuki, Takahashi, and Kumomura, because (1) the use of keyboard timeout signals to trigger a screen saver activation is notoriously well known in the art, and (2) a keyboard timeout is likely to signify that a user is no longer near her computer. Thus, a user would want messages redirected to her mobile device is she is not near her computer. Therefore, it would have been obvious for an internal event in the system taught by Kuki, Takahashi, and Kumomura to include a keyboard timeout signal, as taught by Rakavy.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

For all After Final papers: (703) 746-7238.

For all other correspondences: (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Dung C. Dinh
Primary Examiner

BE
October 15, 2003